

### Remarks

Claims 1-32, 40, 41, 43, and 46-51 are pending in this application, claims 50 and 51 being newly added. Claims 1-8, 11-19, 23-32, 40, 41, 43 and 46-49 are allowed. The only claims remaining in issue are claims 9, 10; 20-22; and new claims 50, 51.

Independent claims 9 and 20 presently stand rejected under 35 U.S.C. 103(a) as being unpatentable over Savoie CA 2166671 in view of Hale et al. 2,906,077. For the reasons which follow, it is respectfully submitted that this rejection should be reconsidered and removed.

Claims 9 and 20 are substantially similar to one another, the difference being that claim 9 is directed to a header alone, while claim 20 is directed to a header as part of a harvesting machine. Both claims are directed to a special conveying roller that is positioned behind the rotary cutters to help air-borne materials from the cutters reach the elevated nip between the conditioning rolls, in spite of the tendency of the problematic lower conditioning roll to reject such materials. Among other things, both claims require the conveying roller to have “an outermost diameter that is smaller than the outermost diameter of the lower conditioning roll.”

The last Office Action takes the position that Savoie discloses all of the claim limitations except for the requirement that the conveying roller have “an outermost diameter that is smaller than the outermost diameter of the lower conditioning roll.” The Office Action goes on to assert that Hale et al. discloses a conveying roller having an outer diameter that is smaller than the outer diameter of the lower conditioning roll and that it “would have been obvious to one having ordinary skill in the art at the time the invention was made to include the conveying roller diameter of Hale et al. on the device of Savoie.”

However, it is respectfully submitted that the invention as claimed in claims 9 and 20 would not have been obvious to one having ordinary skill in the art at the time the invention was made. To the contrary, one of ordinary skill in the art faced with the conditioner roll problem confronting the inventors as of the filing date of the original application would not have been led to solve the problem by combining the teachings of Savoie and Hale et al. in the manner suggested by the Examiner. It is only in hindsight, after reviewing Applicants' disclosure, that one of ordinary skill would discern any benefit in making the overall diameter of Savoie's

conveying roller 31 smaller than the overall diameter of Savoie's lower conditioning roll 34.

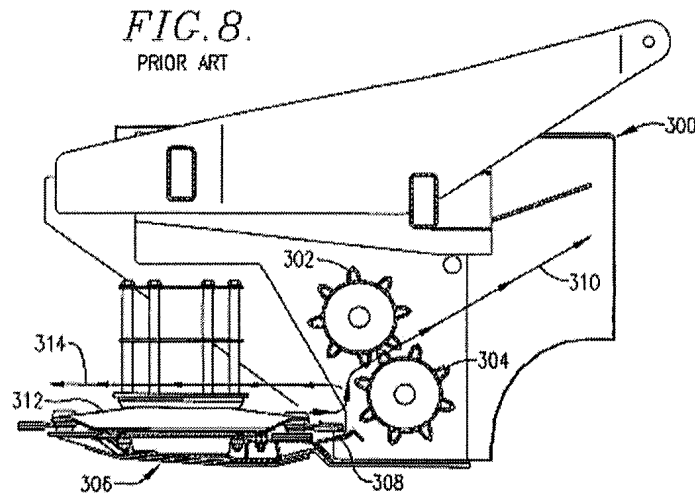
Three criteria must be satisfied in order to establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all the claim limitations. See MPEP §706.02(j), citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992) (reversing an obviousness rejection where there was no suggestion to modify a prior art mower strip to make it entirely flexible as required by applicant's claims on a flexible landscape edging strip); see also *In re Gordon*, 221 USPQ2d 1125, 1127 (Fed. Cir. 1984).

Additionally, "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01.

In meeting this initial burden, the Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). Both the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on the applicant's disclosure. See *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Thus, "[m]easuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." See, e.g., *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983).

As illustrated in Fig. 8 of Applicants' patent 6,158,201, the problem facing Applicants at the time the invention was made involves the fact that the third quadrant of the lower conditioning roll (from 6 o'clock to 9 o'clock) has a tendency to reject air-borne crop materials coming off the rotary cutters. It actually tends to kick those materials back out the front of the machine. This can lead to poor cut-off and other problems.



The conveying roller 31 of Savoie does nothing to solve this problem. In fact, it is just as bad as the conditioning roll 34 behind it because conveying roller 31 is the same diameter as conditioning roll 34 (if not slightly larger). Thus, conveying roller 31 has the same tendency to kick incoming materials from the cutters back out the front of the machine as conditioning roll 34.

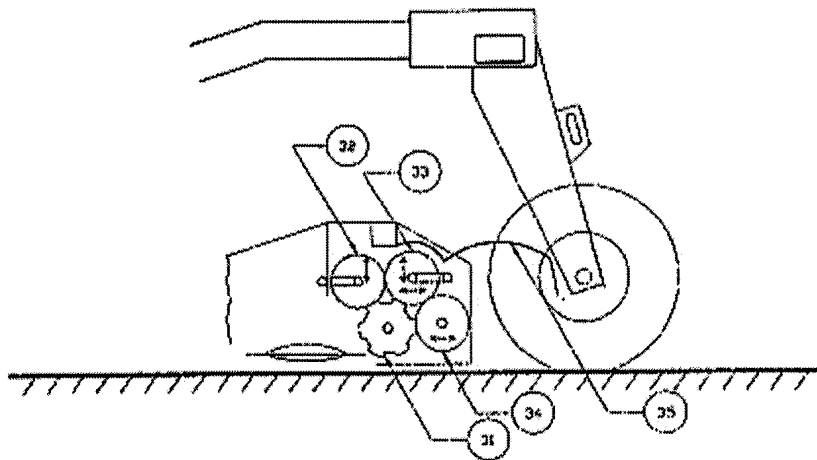
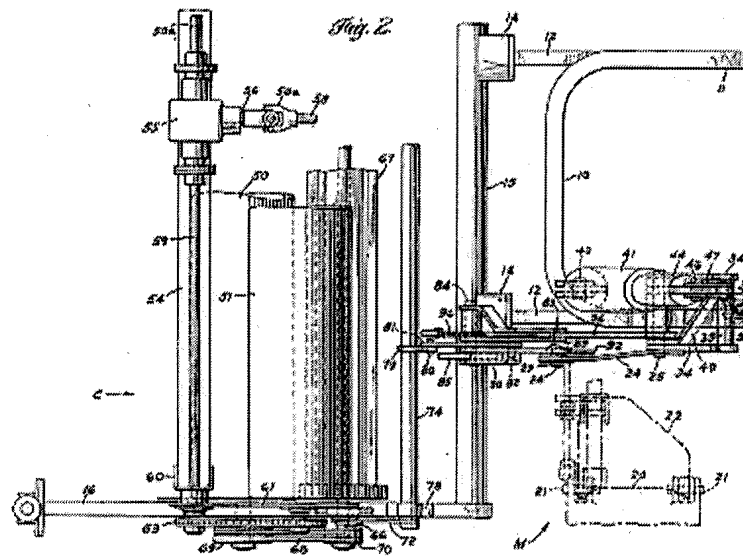


Fig. 10

Does Hale et al. provide any suggestion for solving Savoie's problem? Clearly not.

Hale et al. discloses a machine that is cutting one swath of crop materials while another part of the machine is conditioning material cut during the previous swath. As illustrated perhaps best in Fig. 2, the conditioner C is centered behind the tractor while the mower M (only fragmentarily shown in phantom) is offset to the right of the tractor and conditioner C. Thus, as mower M cuts the standing crop, it falls to the ground and stays there until the next pass of the machine, when conditioner C picks it up off the ground and conditions it as mower M is working in uncut standing crop off to the right side of conditioner C.



It is important to note that conditioner C does not receive materials from mower M, nor, conversely, does mower M propel materials toward conditioner C. Instead, the severed crop materials are lying motionless on the ground when they are approached by conditioner C.

Thus, what the Office Action identifies as “conveying roller 65” in Hale et al. is in reality “a stripperless pick-up reel” having “cross members 67 (Figs. 1 and 2) extending parallel to the rotational axis of the reel and provided with longitudinal, crop engaging, marginal edges which are operable to elevate crop material *on the ground.*” (Col. 3, lines 45-54) Reel 65 does not have to contend with air-borne crop materials flung at it at high speeds from a rotary cutter as

in the present invention -- it only has to reach under the stationary crop materials lying motionless on the ground and lift them into the awaiting conditioning rolls.

If Applicants were claiming that their conveying roll was some kind of a pickup device for lifting stationary, previously severed materials off the ground, Hale's teachings might be helpful. Or if Hale's conditioning rolls were receiving crop materials "on the fly" from mechanism in front of them, the Hale et al. reference might be suggestive of a solution to the problem. However, that is not the case.

Applicants' conditioning rolls have to deal with flying crop materials coming in at high speeds from rotary cutters, and nothing in Hale et al. provides the slightest suggestion of how to deal with that issue. While the overall diameter of Hale's ground-engaging pick-up reel 65 may be smaller than the overall diameter of Hale's lower conditioning roll 50, that does not suggest to one of ordinary skill that the problem of crop rejection by conditioning rolls which receive airborne crop materials from a rotary cutting assembly can be solved by using a conveying roller between the cutting zone and the nip having an outermost diameter that is smaller than the outermost diameter of the lower conditioning roll. Given the different problems facing the Hale et al. conditioning rolls and those of the claimed invention, it is illogical to think that Hale et al. would provide any help at all in solving Applicants' problem. Hale et al. fails to suggest "the desirability of the modification", as required by the *Fritch* case noted earlier (*In re Fritch*, 23 USPQ2d 1780, 183-84 (Fed. Cir. 1992)).

The only prior art teachings of record that might theoretically provide assistance in dealing with the problem of feeding conditioning rolls from rotary cutters are Savoie and Vissers et al. 4,330,982 (cited by Opposer). Both of these references have conditioning rolls that receive cut materials thrown rearwardly by rotary cutters. But Savoie merely illustrates the problem itself rather than a solution because, as noted above, its feed roll 31 is the same overall diameter as, if not larger than, the lower conditioning roll 34. And the Vissers et al. rotating auger drum 63 between the rotary cutters and conditioning rolls is obviously considerably larger in overall diameter than the lower conditioning roll. So Vissers et al. is no help either.

Thus, in the rotary cutter prior art, where one of ordinary skill might reasonably be expected to turn for help in how to deal with Applicants' problem of conditioning rolls rejecting incoming crop materials from rotary cutters, no help exists. That help is provided for the first time by Applicants' own disclosure.

As a consequence, there clearly is no “suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings” (Savoie and Hale et al.) as required by MPEP §706.02(j) and *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). Accordingly, the claimed invention of claims 9 and 20 cannot properly be held to be a mere obvious modification of Savoie in view of Hale et al., and the rejection of these claims under 35 U.S.C. 103(a) should be reconsidered and removed.

Claims 10 and 21 are dependent claims depending from claims 9 and 20, respectively. Both of these claims have been rejected under 35 U.S.C. 103(a) as being an obvious modification of Savoie in view of Hale et al. The Office Action asserts in particular that in Hale et al. “a conveying roller (65) axis is generally vertically aligned with the plane of the cutting zone (M, see Figure 4).”

It is respectfully submitted that this rejection has no foundation for many of the same reasons given above with respect to claims 9 and 20. Hale's pick-up reel 65 is not disposed to receive crop materials from mower M. Instead, it is offset to one side of mower M and engages stationary material lying on the ground. Hence, it is not truly “aligned vertically” with the cutting zone and fails to meet the further claim requirement of having “at least a portion thereof that moves upwardly and rearwardly between the cutting zone and the nip to convey crop cut by the cutting assembly toward the nip.” Consequently, it is respectfully submitted that dependent claims 10 and 21 are also in full condition for allowance.

Claim 22 depends from allowable claim 20 and sets forth further details of the claimed invention. Accordingly, although this claim was rejected as claiming subject matter that is merely an obvious modification of Savoie in view of Hale et al. and Van der Lely et al., it is respectfully submitted that claim 22 is in condition for allowance as well, for the reasons set forth above with respect to claims 9 and 20.

New independent claim 50 contains all the limitations of patent claim 1 plus additional limitations and is therefore narrower than patent claim 1. Claim 50 is similar in many respects to allowed, amended claim 1 but sets out the relationship between the lower conditioning roll, the conveying roller, and the rotary cutting plane in a somewhat different manner. Among other things, claim 50 specifies that the upper forward peripheral portion of the conveying roller is “disposed in front of the lower forward peripheral portion of the lower conditioning roll and generally below the axis of rotation of the lower conditioning roll.” Further, claim 50 specifies that the “conveying roller project[s] downwardly below the plane of said cutting zone.”

This relationship is simply not shown or suggested by the prior art. Perhaps the closest reference is Savoie, where the feed roll 31 is located in front of the conditioning rolls 33, 34. But the upper forward peripheral portion of the feed roll 31 is not “in front of the lower forward peripheral portion of the lower conditioning roll and generally below the axis of rotation of the lower conditioning roll” as required by claim 50. To the contrary, it is generally above the axis of rotation of the lower conditioning roll.

Moreover, the feed roll 31 of Savoie does not project “downwardly below the plane of said cutting zone” defined by the knives. At best, it only projects downwardly to the plane of the cutting zone.

Accordingly, it is respectfully submitted that new independent claim 50 sets forth subject matter not shown or suggested by the prior art. Furthermore, it is narrower in many respects than claim 1 as originally patented. Therefore, claim 50 is allowable along with its new dependent claim 51, which specifies that “said conveying roller compris[es] a single roller, unaccompanied by an upper roller forming a nip therewith.” This clearly distinguishes over Savoie who requires an upper roller 32 that engages and forms a nip with feed roller 31.

Accompanying this response and made a part hereof, pursuant to 37 C.F.R. §1.173c, is a THIRD STATEMENT OF STATUS AND SUPPORT FOR CHANGES TO CLAIMS. Also submitted is a Supplemental Declaration from the assignee.

In addition Applicant submits herewith a Petition for a two-month extension of time for responding to the Office Action of November 21, 2006.

In view of the foregoing, it is respectfully submitted that all remaining claims in this application are in full condition for allowance, and it is requested that formal notice of such allowance be issued in due course.

Respectfully submitted,

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